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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,084	02/06/2004	Wayne Boga	METSO-19	7142
36528 7590 05/04/2007 STIENNON & STIENNON 612 W. MAIN ST., SUITE 201 P.O. BOX 1667 MADISON, WI 53701-1667			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	
			MAIL DATE	DELIVERY MODE
			05/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/774,084

Applicant(s)

BOGA ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/6/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election***

1. Applicant's election without traverse of Group I, Claims 1-2, in the reply filed on February 21, 2007 is acknowledged. Applicant cancelled claims 1-14 and added claims 15-34, which are pending.

### ***Claim Rejections – 35 USC 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, the phrase, "a suction roll seal strip for placement in a holder of a stationarily supported suction box in a paper machine, the suction box connected to a vacuum source...around the suction box" is indefinite. It is unclear whether Applicant is claiming a suction roll seal strip or a suction box. Clarification is requested.

### ***Objection***

4. Claim 29 is objected to for further broadening claim 27.

***Claim Rejections – 35 USC § 103(a)***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selover, Jr. et al. (U.S. 4,014,730).

Selover, Jr. discloses a sealant, where the sealant is a polymer such as natural or nitrile rubber, which is incorporated into a graphite sheet (column 2, lines 18-35 and 49-67) where wax is mixed with the graphite-rubber composite (column 3, lines 1-7). The reference teaches the wax is 2% parts by weight of the mixture and the mixture further can include sulfur at 2% parts by weight (column 5, lines 50-55) and the graphite (carbon black) is less than about 50 parts per hundred parts of rubber (column 6, lines 49-51) which meets the limitation of instant claim 20.

Although Selover, Jr. does not teach cross section, radius or flexibility of the seal material, it would have been obvious to one of ordinary skill in the art to include these features because Selover, Jr. teaches the same materials having the same function as applicants claimed invention. With respect to the claimed teach cross section, radius and flexibility of the composite laminate, these features are directly related to the specific mixture used. Since the reference uses the same nitrile rubber, graphite and wax as claimed by applicant, the cross section, radius and flexibility of the glass

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laminate would be expected to be the same as Applicant claims. In claims 15, 17 and 26, the phrases, "to allow a seal with a cross-section of 1.9cm by 4.8 cm to be bent into a reel with a radius of less than 150 cm", "permits the seal strip to be bent onto a reel" and "can be rolled onto a reel with a radius of less than 1.5m" respectively constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

In all of the above mentioned claims, the instant invention includes the preamble language of, "a suction roll seal strip". A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, the preamble language has not been accorded patentable weight.

### ***Claim Rejections – 35 USC § 103(a)***

7. Claims 24-25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Selover, Jr. et al. (U.S. 4,014,730) in view of Sale et al (U.S. 6,258,409).

Selover, Jr. is relied upon for instant claim 15. Selover, Jr. does not disclose specific wax material, as cited in claims 27-29. Sale teaches a sealant with a wax comprising ethylene bis-stearamide, which has a melting point of about 110°C to about 180°C (column 1, lines 11-25 and column 4, lines 6-13 and 44-48). Sale further teaches polyethylene waxes (polyolefin waxes) have been used in sealants as well (column 6, lines 30-40). Selover, Jr. and Sale are both related to sealants with wax. It would have been obvious to one of ordinary skill in the art to have employed the ethylene bis-stearamide wax, as taught in Sale, in the sealant mixture of Selover, Jr. because the ethylene bis-stearamide wax retains the integrity of the seal.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ashizawa et al (U.S. 4,956,226) teaches a rubber layer with a dispersion of graphite in a wax binder (column 6, lines 15-20). The reference lacked the mixture being in a seal strip form. Additionally, Persson et al (U.S. 6,436,241) teaches a seal strip having a rubber graphite composition (column 4, lines 3-10 and 34-38) but lacks a wax component.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-

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272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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